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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/648,259 | 08/27/2003 | Steven Su | BHT-3123-99 | 5222 |

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EXAMINER

PARRIES, DRU M

ART UNIT PAPER NUMBER

2836

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,259

Applicant(s)

SU, STEVEN

Examiner

Dru M. Parries

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed May 24, 2006 have been fully considered but they are not persuasive. The Examiner disagrees with the Applicant's analysis of the Chan et al. reference. Chan teaches a method where a CD-ROM can play a CD at the same time as the main computer system not being supplied with power (i.e. the main supply power supply of Westerinen is turned off). This is taught in the Chan reference – [0024] & [0026]. Therefore, the combination of Westerinen and Chan teaches “an auxiliary power supply providing power to at least one computer peripheral appliance (CD-ROM) to allow operation of the computer peripheral appliance regardless of whether the system main power supply is turned on or off.”
2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Chan with Westerinen is to minimize power consumption. For example, if someone only wanted to play a CD on the CD-ROM of Westerinen's computer, without using any other part of the computer, a lot of power could be conserved if the method taught in Chan was implemented into Westerinen's invention.

Regarding the combination of Steigerwald with Chan and Westerinen, the fact that Westerinen was silent as to how the inner circuitry of the DC-DC converter looked, an ordinary artisan would have been motivated to find circuitry for the DC-DC converter to make it function

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the way it is taught in Westerinen, and because Steigerwald teaches an inner circuitry structure that allows it to function in that way then it would have been obvious to combine the two references.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerinen et al. (2004/0088589) and Chan et al. (2004/0181616). Westerinen teaches a power supply system for a computer. He teaches an AC input (input to 78), an AC-DC converter (i.e. rectifier, 78) and DC-DC converter (80) to regulate a plurality of DC output voltages to a variety of peripheral devices (i.e. optical drives; 28). He also teaches the DC voltage being diverted into at least three different power supplies (outputs to 18, 110, and 108). The main power supply is considered to be the outputs to the motherboard (18, where the processor is) and the hard drive (23), and the other two supplies are considered to be two of the voltages out of connector (108) ([0022], lines 1-12). Westerinen fails to teach permitting operation of computer peripheral appliances, whether the computer main system is switched on or off. Chan teaches an operating mode where when the computer main system is turned off, it still allows for the peripheral devices to continue operation (CD-ROM drive to be on and playing audio CDs) (Abstract; [0024] & [0026]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Chan's operation mode into Westerinen's invention so that power can

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be saved throughout the computer power supply system. If someone wants to only play an audio CD and not use the computer, it will allow for lower power consumption of the power supply.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Westerinen et al. (2004/0088589) and Chan et al. (2004/0181616) as applied to claim 1 above, and further in view of Steigerwald et al. (2004/0032239). Westerinen and Chan teach a power supply system for a computer as described above. They both fail to teach the inner circuitry of DC-DC converter (80). Steigerwald teaches a DC-DC converter that takes in one DC input voltage and outputs a plurality of different DC voltages, and has one independent coil (N1). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Steigerwald's circuitry into Westerinen's DC-DC converter because it is a known system that works in the art and Westerinen doesn't explicitly teach what the inner circuitry is.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dru M. Parries whose telephone number is (571) 272-8542. The examiner can normally be reached on M-Th from 8:00am to 5:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus, can be reached on 571-272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMP

6-15-2006



ROBERT L. DEBERADINS
PRIMARY EXAMINER